

Attorney Docket No.: E-1902

**REMARKS**

Claims 21-25, 27-29 and new claims 49-53 are pending in the application. Claims 1-21 and 31-48 have been cancelled, without prejudice. Claims 22-25 and 27-29 stand rejected. Reconsideration and a withdrawal of the Examiner's rejections are hereby respectfully requested.

**1. The Examiner's Section 112 Rejection.**

Claims 22-25, 27-29, stand rejected under 35 U.S.C. Section 112 as being indefinite. Applicant respectfully but strenuously traverses this rejection and reconsideration and a withdrawal of the rejection are hereby requested.

The Examiner, in particular, points to claim 22, lines 2-3 and 13-14, referring to the language "such as insects." Applicant has amended claim 22 to delete "such as insects" from the claim to render the claim definite. This amendment does not alter the meaning of the claim content since crawling pests is broad and would include insects. In view of the amendment, Applicant hereby respectfully requests reconsideration and a withdrawal of the Examiner's Section 112 rejection.

**2. The Examiner's Section 102 Rejection of Claim 22 as Being Anticipated by US 5,555,673 ("Smith").**

Claim 22 stands rejected under 35 U.S.C. Section 102(b) as being anticipated by US 5,555,673 ("Smith"). This rejection is respectfully but strenuously traversed and reconsideration and a withdrawal of the rejection are hereby respectfully requested.

Applicant's present invention is not anticipated by Smith. The present invention is distinguishable over the Smith reference. The Examiner contends that Smith discloses a method of eliminating unwanted vegetated growth with a herbicide for controlling crawling pests such as insects when a pesticide is used comprising providing a compound comprising either a herbicide or pesticide compound in a reservoir; selectively delivering the compound to an applicator by increasing internal

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pressure of the reservoir forcing through a regulatable valve (col. 4 lines 30-33); directly contacting a surface with the application; regulating the flow of the compound delivered by the applicator by varying the internal pressure or the regulatable valve (col. 4 lines 30-33); wherein the step of directly contacting a surface comprises contacting unwanted vegetation when a herbicide is in the reservoir, and wherein the step would directly contacting a surface comprises contacting a surface which crawling pests such as insects can cross when a pesticide is in the reservoir. Smith does not disclose, nor does it suggest or teach the method disclosed and claimed as the Applicant's present invention.

The Smith device provides for sliding a first part relative to another, and fails to teach, suggest or disclose the Applicant's present invention where the method of eliminating unwanted vegetation growth or controlling crawling pests provides a compound in a reservoir, and is capable of selectively delivering the compound through an applicator onto a surface while the flow is being regulated. The Examiner's contention and reference to col. 4 lines 30-33 of Smith supports the distinction, and only further serves to differentiate the applicant's presently claimed invention from the cited reference. With Smith, if the valve can be readily depressed, even the slightest contact of the sponge (108) with an object will provide an open flow. However, Smith discloses a biasing spring so there is a force to overcome in order to open the Smith valve. The force to be overcome may require that the user force the Smith sponge (108) against an object other than the intended object, such as for example the ground, since smaller diameter vines may not be substantial enough to compress and overcome the bias of the Smith spring member. If this happens, the Smith valve would not deliver fluid but would remain closed. The Applicant's method therefore attempts to alleviate and overcome the potential deficiencies of the Smith method and device.

The Applicant's invention permits flow to travel through a valve so that continuous flow of liquid from the reservoir is possible when the applicator, such as for example the applicator disclosed in a preferred embodiment comprising a brush, is

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in contact with unwanted vegetation. Moreover, Smith, unlike the applicant's present invention, discloses a sponge (108) which is configured to absorb an amount of fluid (8), and hold the fluid (8) until the fluid (8) is transferred from the sponge (108) to another object. (See col. 11 line 67 through col. 12 line 26.) Smith does not disclose, nor does it teach or suggest the applicant's present invention. That the applicant's disclosure provides an applicator which may comprise an element other than a sponge (108) is telling of the difference in the applicant's claimed method as compared with Smith. Smith relies on the sponge (108) to receive a portion of the fluid, and then dispenses the fluid from the sponge (108) by contacting the sponge (108) to the object. The Smith method and device discloses a non-continuous flow (see col. 11 line 67 through col. 12 line 26), so that when the sponge (108) has delivered its fluid, the sponge (108) must be saturated again before delivery of the fluid from the sponge (108) may resume. That is what appears to be the fair teaching or disclosure of Smith. Applicant's present method claims the steps of selectively delivering the compound from the reservoir to an applicator, directly contacting a surface with the applicator, and regulating the flow of said herbicide or pesticide delivered by said applicator to the surface where a user may increase or decrease the flow volume during application of the herbicide or pesticide to a surface. Smith, for the above reasons, does not disclose or suggest these features.

In addition, the applicant's present invention is further distinguishable over Smith. To deliver fluid with Smith, one would need to open the stopper (62) of the Smith valve and then turn the Smith device upside down. The result is that no liquid would come out at all unless the valve is open. In order to maintain the Smith valve in an open position, two hands appear to be required. If a user chooses, the Applicant's method may be carried out using a single hand to regulate the flow of herbicide being delivered, regardless of the type of applicator employed.

In Smith, in order to dispense fluid to the sponge, the container 12 must be held, and the dispensing assembly also must be held, or alternatively pressed against a surface for release. This is not the method claimed by the applicant. In addition, if a

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brush were to be used in the manner disclosed by Smith, the brush would likely need to flatten against a surface in order to have some type of flow through the valve. This is yet another telling deficiency of Smith. It therefore cannot fairly be contended that Smith discloses the Applicant's present method of applying a herbicide or pesticide. These are further reasons one of ordinary skill in the art would not be led by Smith to make any modifications to transform what is disclosed in Smith into the method disclosed and claimed by Applicant's present invention. It is impermissible to rely on a modification which itself destroys the function of the reference, as would making any proposed modification to Smith. See *Ex parte Acosta*, 211 U.S.P.Q. 636 (P.T.O. Bd. App. 1979). One of ordinary skill in the art therefore would not gain from Smith the necessary motivation to derive a method for applying a herbicide or pesticide where regulating the flow from the reservoir to the applicator may be done during the delivery of the liquid to a surface. It is only through the hindsight benefit of the Applicant's disclosure, and not Smith, that the motivation to provide the step of regulating the flow of said herbicide or pesticide delivered by said applicator to the surface by varying at least one of the internal pressure of the reservoir and the position of the regulatable valve is disclosed. Smith, however, does not even disclose or suggest the applicant's present method. It is impermissible to use hindsight and rely on the applicant's own disclosure in order to support a rejection. Moreover, Smith does not teach or disclose the method claimed by the Applicant's invention where the flow may be regulated.

Applicant has added new claims 49-53 to round out the coverage of the invention. For the reasons set forth herein, Applicant submits that new claims 49-53 disclose a recite a novel and non-obvious invention which is also distinguishable over Smith and not suggested or disclosed by Smith. Applicant's invention as recited in claims 49-53 should be patentable.

The present method disclosed and claimed by the Applicant is distinguishable over Smith and should be patentable. Applicant hereby respectfully requests reconsideration and a withdrawal of the Examiner's Section 102(b) rejection with

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respect to claim 22. New claims 49-53, also distinguish the Applicant's present invention over Smith and should be patentable.

**3. The Examiner's Section 103(a) Rejection as Claim 23 as being Unpatentable over Smith.**

Claim 23 stands rejected under 35 U.S.C. Section 103(a) as being unpatentable over Smith. This rejection is respectfully but strenuously traversed and reconsideration and a withdrawal of the Examiner's rejection are hereby respectfully requested.

Applicant's present invention is not obvious in view of Smith. Claim 23 depends from claim 22, and, for the same reasons set forth above distinguishing claim 22 from Smith, claim 23 is also not taught, suggested or disclosed by Smith. Applicant's invention as recited in claim 23 should be patentable.

**4. The Examiner's 103(a) Rejection of Claims 24, 25, 27, 28 and 29 as being Unpatentable over Smith in View of US Patent 3,993,208 ("Ostrowsky").**

Claims 24, 25, 27, 28 and 29 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Smith in view of Ostrowsky. This rejection is respectfully but strenuously traversed and reconsideration and a withdrawal of the rejection are hereby respectfully requested.

Applicant's present invention as recited in claims 24, 25, 27, 28 and 29 is distinguishable over the cited prior art references and should be patentable. The Examiner contends that Smith is deficient in a teaching of a safety cover means with securing means of rotating the cover means past a predetermined stop to block reverse rotation. For the reasons set forth above distinguishing the Applicant's presently claimed invention over Smith, claims 24, 25, 27, 28 and 29, which depend from claim 22 should also be patentable.

Applicant has considered the prior art made of record but not relied upon, and, for the same reasons set forth herein, submits that the Applicant's present invention should be patentable over the prior art of record.

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If further matters remain in connection with this case the Examiner is invited to telephone the Applicant's undersigned representative to resolve them.

In the event that a fee is required or an additional fee or amount is required in connection with the filing of this amendment, the Commissioner is hereby authorized to charge a fee or additional fee to Deposit Account Number 05-0208.

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In the event that an extension of time, or additional extension of time if one has already been requested, is required, the Commissioner is hereby respectfully requested to consider this a request for a petition for the necessary extension of time and to charge any fees to Deposit Account No. 05-0208.

Respectfully submitted,  
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In re Application of  
ARTHUR M. TOFANI, et al.  
U.S. Patent Application No. 09/689,459  
Filed: October 12, 2000  
For: METHOD AND DEVICE FOR THE CONTROLLED DELIVERY OF  
HERBICIDES AND PESTICIDES

Examiner: Jeffrey L. Gellner  
Art Unit: 3643

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

SIR:

**APPENDIX OF AMENDED AND NEW CLAIMS**  
**MARKED TO SHOW CHANGES**

22. (Twice Amended) A method for eliminating unwanted vegetation growth when a herbicide is used or for eliminating or controlling crawling pests [such as insects] when a pesticide is used, comprising the steps of: (a) providing a compound comprising a herbicide or pesticide compound in a reservoir; (b) selectively delivering the herbicide or pesticide compound from the reservoir to an applicator by increasing the internal pressure of the reservoir and forcing said compound through a regulatable valve; (c) directly contacting a surface with the applicator; and (d) regulating the flow of said herbicide or pesticide delivered by said applicator to the surface by varying at least one of the internal pressure of the reservoir and the position of the regulatable valve, wherein the step of directly contacting a surface comprises contacting unwanted vegetation when a herbicide is provided in the reservoir, and wherein the step of directly contacting a surface comprises contacting a surface which crawling pests [such as insects] can cross when a pesticide is provided in the reservoir.



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## New Claims:

--49. A method for eliminating unwanted vegetation growth when an herbicide is used or for eliminating or controlling crawling pests such as insects when a pesticide is used, comprising the steps of: (a) providing a compound comprising a herbicide or pesticide compound in a reservoir; (b) selectively delivering the herbicide or pesticide compound from the reservoir to an applicator by decreasing the volume of the reservoir and forcing said compound through a regulatable valve; (c) directly contacting a surface with the applicator; and (d) regulating the flow of said herbicide or pesticide delivered by said applicator to the surface by varying either the volume of the reservoir or the position of the regulatable valve, wherein the step of directly contacting a surface comprises contacting unwanted vegetation when an herbicide is provided in the reservoir, and wherein the step of directly contacting a surface comprises contacting a surface which crawling pests such as insects can cross when a pesticide is provided in the reservoir.

50. A method for eliminating unwanted vegetation growth when an herbicide is used or for eliminating or controlling crawling pests such as insects when a pesticide is used, comprising the steps of: (a) providing a compound comprising a herbicide or pesticide compound in a reservoir; (b) selectively delivering the herbicide or pesticide compound from the reservoir to an applicator through a regulatable valve; (c) directly contacting a surface with the applicator; and (d) regulating the flow of said herbicide or pesticide delivered by said applicator to the surface by varying either the volume of the reservoir or the position of the regulatable valve, wherein the step of directly contacting a surface comprises contacting unwanted vegetation when an herbicide is provided in the reservoir, and wherein the step of directly contacting a surface comprises contacting a surface which crawling pests such as insects can cross when a pesticide is provided in the reservoir.

51. A method for eliminating unwanted vegetation growth when a herbicide is used or for eliminating or controlling crawling pests such as insects when a pesticide is used, comprising the steps of: (a) providing a compound comprising a

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herbicide or pesticide compound in a reservoir; (b) selectively delivering the herbicide or pesticide compound from the reservoir to an applicator; (c) directly contacting a surface with the applicator; and (d) regulating the flow of said herbicide or pesticide delivered by said applicator to the surface by varying the volume of the reservoir, wherein the step of directly contacting a surface comprises contacting unwanted vegetation when a herbicide is provided in the reservoir, and wherein the step of directly contacting a surface comprises contacting a surface which crawling pests can cross when a pesticide is provided in the reservoir.

52. A method for eliminating unwanted vegetation growth when a herbicide is used or for eliminating or controlling crawling pests such as insects when a pesticide is used, comprising the steps of: (a) providing a compound comprising a herbicide or pesticide compound in a reservoir; (b) selectively delivering the herbicide or pesticide compound from the reservoir to an applicator by increasing the internal pressure of the reservoir and forcing said compound through a regulatable valve; (c) directly contacting a surface with the applicator; and (d) regulating the flow of said herbicide or pesticide delivered by said applicator to the surface by varying at least one of the internal pressure of the reservoir and the position of the regulatable valve, and providing a valve and regulating the valve to maintain an open channel of communication between the reservoir and the applicator to permit a controllable flow from the applicator to the reservoir, wherein the step of directly contacting a surface comprises contacting unwanted vegetation when a herbicide is provided in the reservoir, and wherein the step of directly contacting a surface comprises contacting a surface which crawling pests can cross when a pesticide is provided in the reservoir.

53. A method for eliminating unwanted vegetation growth when a herbicide is used or for eliminating or controlling crawling pests such as insects when a pesticide is used, comprising the steps of: (a) providing a compound comprising a herbicide or pesticide compound in a reservoir; (b) selectively delivering the herbicide or pesticide compound from the reservoir to an applicator; (c) directly contacting a surface with the applicator; and (d) regulating the flow of said herbicide

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or pesticide delivered by said applicator to the surface by varying at least one of the internal pressure of the reservoir and the position of a regulatable valve, wherein the step of regulating with a valve includes applying a force to move a valve element from a first position to a second position which permits flow communication from said reservoir to said applicator, and releasing the force being applied to allow the valve element to be maintained in said second position, wherein the step of directly contacting a surface comprises contacting unwanted vegetation when a herbicide is provided in the reservoir, and wherein the step of directly contacting a surface comprises contacting a surface which crawling pests can cross when a pesticide is provided in the reservoir.--